

09/826,612
Art Unit 3693
Docket 8963.00

REMARKS

This Amendment is submitted in response to the Office Action mailed on July 3, 2006. Claims 1 - 19 are pending, and all stand rejected at present.

Independent claim 11 is cancelled, and independent claim 20 is added. No fee is due.

Support for the amendments to the claims can be found in the Specification at the following locations, and others.

Claims	Location of Support
1	Page 2, lines 20 - 22; page 2, lines 12, 13; page 2, lines 8, 9; page 1, lines 18 - 20.
4, 5, 8	Page 3, and as in claim 1.
10, 12	As above.

BRIEF DESCRIPTION OF ONE FORM OF THE INVENTION

A self-service terminal, such as an ATM, offers access to the Internet. A user can use the ATM to visit a web site, to make a purchase.

The user pays the terminal/ATM for the purchase, and does not pay the seller. The terminal/ATM then pays the seller, using the terminal's own resources, such as a credit card owned by the terminal. The identity of the purchaser is thus not disclosed to the seller.

09/826,612
Art Unit 3693
Docket 8963.00

re: CLAIM 9

Applicant points out that claim 9 has not been rejected. Thus, claim 9 should be allowed.

Further, claim 9 states that "an owner of the network is liable for payment of the financial instruments." One example of this recitation is found in the Brief Description immediately above: the terminal pays for the purchase using the terminal's own credit card.

This is not seen in the applied references.

RESPONSE TO ANTICIPATION REJECTIONS

Claims 1, 3 - 7, 10 - 12, and 14 - 18 were rejected on grounds of anticipation, based on Barcelou.

Barcelou Reference

Barcelou discusses a system wherein a user can visit a kiosk which provides a computer which allows access to the Internet. The user can use the computer to visit web sites of merchants. The kiosk is equipped with devices to accept payment from the user. Thus, the user can make purchases from the web sites at the kiosk.

Barcelou indicates that, if the user swipes a credit card at the kiosk, the credit card information is transmitted to the

09/826,612
Art Unit 3693
Docket 8963.00

merchant's web site. Barcelou gives the example of purchasing gasoline using a credit card. (Column 5, lines 21 - 24.) Plainly, the gas station relays the credit card information to a central office which manages the gas station, or at least which handles payment for the gas station.

Applicant points out that, in Barcelou's system, the identity of the credit card user is disclosed to the seller's web site. For example, the undersigned attorney frequently purchases lumber and tools from a specific home center, using a credit card. The home center prints a receipt bearing the name of the undersigned attorney. This name is clearly derived from the mag-stripe on the credit card, or from the credit card company based on the account number read from the mag-stripe, a combination of these two sources, or in some other way, based on the credit card.

Thus, in an ordinary credit card transaction, as in Barcelou, the identity of the purchaser is disclosed to the seller.

Under one form of the invention, the identity is not disclosed: the purchaser remains anonymous. (See Specification, page 2, lines 12, 13 and lines 8, 9.)

Claim 1

Amended claim 1 states, in simple terms, that the identity of the purchaser is not disclosed to the seller, even if the purchaser pays the terminal via credit card.

09/826,612
Art Unit 3693
Docket 8963.00

Restated, claim 1 sets forth four examples of how payment can be made to the terminal, and states that the identity of the purchaser is not disclosed to the seller in any of those four cases.

Barcelou states that he identifies the user of his terminal. (Column 4, lines 27 - 39.) That is somewhat contrary to the claim.

However, assume **arguendo** that, in Barcelou, (1) all persons are not identified, and (2) a non-identified person pays cash to Barcelou's terminal. It can be argued that, in this case, this person's identity will not be revealed to the seller.

But that does not show claim 1, because claim 1 states that the identity of a person using a **credit card** (for example) is not identified to the seller. (As explained above, the person can pay the terminal using a credit card, but the terminal pays the seller using its own credit card. To the seller, the terminal is the purchaser, and the actual purchaser is anonymous to the seller.)

In contrast, in Barcelou, the identity of the credit card purchaser is disclosed to the seller. It is possible that the disclosure is by way of a computer operated by the credit card company, and not by Barcelou himself, but the disclosure is made nevertheless.

Claims 4 and 5

As to claim 4, Applicant points out that the claimed

09/826,612
Art Unit 3693
Docket 8963.00

"electronic financial instrument" is created by the terminal, and sent to the seller. That is not seen in Barcelou.

Barcelou merely reads the mag-stripe on a credit card, and relays that information to the seller, as at a gasoline pump.

Applicant requests, under 37 CFR §§ 1.104(c)(2) and 35 U.S.C. § 132, that the PTO specifically identify the "electronic financial instrument" in Barcelou.

The Office Action appears to find the claimed "financial instrument" in something which is given to Barcelou's customer, such as data loaded into the customer's smart card. That does not correspond to the claimed "instrument."

Claim 5 states that the "instrument" comprises a credit card. Applicant requests that this be identified in Barcelou.

Amendments to claims 4 and 5 state that in "instrument" is based on an account maintained by the terminal. This is seen as a clarification of existing language in the claims.

Claim 10

Claim 10 states that the payment for the purchase is made by the terminal. That is not seen in Barcelou. Again, Barcelou merely relays credit card information, or the like, to the seller.

The amendment to claim 10(c) is seen as redundant, because the original claim states that the "terminal" makes the payment.

Claim 10 states that the purchaser remains anonymous. That

09/826,612
Art Unit 3693
Docket 8963.00

is not seen in Barcelou.

Claim 11

Claim 11 is amended because the original may be read on Barcelou, in the sense that if Barcelou accepts cash from a customer for a purchase over the Internet (which is not explicitly stated in Barcelou), then Barcelou's terminal must somehow pay for the purchase.

Remaining Claims

The discussion above applies to the remaining claims in this group.

RESPONSE TO OBVIOUSNESS REJECTIONS

Claims 2, 8, 13, and 19 were rejected as obvious, based on Barcelou and Flenley. Flenley is cited as showing a "browser," which is added to Barcelou.

However, Applicant submits that several problems exist in the combination of references.

Problem 1

The rationale for combining the references is that Flenley's browser is an "alternative" to Barcelou's touchscreen. However, Applicant points out that this is incorrect, as a matter of fact.

09/826,612
Art Unit 3693
Docket 8963.00

A browser is software. A touchscreen is hardware. One can use a touchscreen to issue commands to a browser.

A browser is not, in fact, an alternative to a touchscreen.

Problem 2

The rationale is applying the principle of substitution-of-known-equivalents. MPEP § 2144.06 states:

In order to rely on equivalence as a rationale supporting an obviousness rejection, **the equivalency must be recognized in the prior art**, and cannot be based on . . . the mere fact that the components at issue are functional or mechanical equivalents.

The rejection fails to comply with this MPEP section. Recognition of the equivalence in the prior art has not been shown.

Problem 3

No expectation of success has been shown in replacing Barcelou's touchscreen with a browser. MPEP § 706.02(j) states:

Contents of a 35 U.S.C. 103 Rejection

. . . .

To establish a prima facie case of obviousness, three basic criteria must be met.

. . . .

Second, **there must be a reasonable expectation of success.**

09/826,612
Art Unit 3693
Docket 8963.00

. . . .

The . . . reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

The PTO has not shown how the browser, when substituted for the touch screen, performs the functions of the touch screen, which include

- displaying images,
- displaying buttons for the user to touch, and
- detecting the touching, and issuing commands in response.

Also, the expectation of success in the prior art has not been shown, as required.

Problem 4

The combination of references renders Barcelou inoperative. If his touchscreen is removed, then his users cannot interact with his computer. MPEP § 2143.01 prohibits this:

THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE.

. . . .

THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF OPERATION OF A REFERENCE.

09/826,612
Art Unit 3693
Docket 8963.00

Problem 5

No actual teaching has been given for modifying Barcelou. The Office Action has merely asserted (incorrectly) that one element in Flenley is an "alternative" to an element in Barcelou.

That is merely a statement of fact (if true, which is not the case). That is not a teaching for combining the references.

Problem 6

MPEP § 2143.01 states:

FACT THAT REFERENCES **CAN BE** COMBINED OR
MODIFIED IS NOT SUFFICIENT TO ESTABLISH PRIMA
FACIE OBVIOUSNESS

The mere fact that references can be combined
or modified does not render the resultant
combination obvious unless the prior art also
suggests the desirability of the combination.

. . .

FACT THAT THE CLAIMED INVENTION IS WITHIN THE
CAPABILITIES OF ONE OF ORDINARY SKILL IN THE
ART IS NOT SUFFICIENT BY ITSELF TO ESTABLISH
PRIMA FACIE OBVIOUSNESS

A statement that modifications of the prior
art to meet the claimed invention would have
been "well within the ordinary skill of the
art at the time the claimed invention was
made" because the references relied upon teach
that all aspects of the claimed invention were
individually known in the art is not
sufficient to establish a prima facie case of
obviousness without some objective reason to
combine the teachings of the references.

09/826,612
Art Unit 3693
Docket 8963.00

Applicant submits that the essential basis of the PTO's rationale for rejecting the claims is no different than the two types of bases which are **specifically prohibited** by this MPEP section.

Restated, this MPEP section states that an invention is not obvious merely because

- references "can be" combined to attain it,
- or
- the combination is "well within the skill of the art."

The PTO's rationale, in essence, is no different than these two prohibited rationales. In essence, the PTO asserts that the browser is an "alternative" to the touchscreen.

Thus, the PTO tacitly states that

- the browser "can be" substituted for the touchscreen, or
- the substitution is within the skill of the art.

Applicant submits that the PTO is, in effect, applying the two prohibited rationales discussed above.

ADDED CLAIM 20

Claim 20 states that the customer is kept anonymous with respect to the merchant, and that the ATM pays the merchant, no

09/826,612
Art Unit 3693
Docket 8963.00


matter how the customer pays the ATM. These recitations are not seen in the applied references.

CONCLUSION

Applicant requests that the rejections to the claims be reconsidered and withdrawn.

Applicant expresses thanks to the Examiner for the careful consideration given to this case.

Respectfully submitted,


Gregory A. Welte
Reg. No. 30,434

NCR Corporation
1700 South Patterson Blvd
WHQ - 3
Dayton, OH 45479
October 3, 2006
(937) 445 - 4956